

REMARKS

Claims 1-3, 6-15, 19-23, 25-31, 33, 69-72, 75, 76, 85 and 86 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,375,683 to Crozet et al., claims 1-3, 6-12, 23-31, 4, 67-72, 74, 77, 84-86 and 88 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0107519 to Dixon et al., and claims 1-3, 6-11, 17-19, 21, 23-30, 32-34 and 63-90 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 7,195,643 to Jackson.

Removal of U.S. Patent No. 7,195,643 to Jackson as Prior Art via the Antedating Declaration

The Advisory Action mailed on December 20, 2007 indicates that “[t]he affidavit . . . will not be entered because Applicant failed to provide evidence (e.g., proof of conception) of several limitations claimed in the dependent claims (e.g., claims 19-22, among other claims).” The Applicant respectfully disagrees with this assertion for the following reasons.

As an initial matter, the effectiveness of a Declaration submitted under 37 C.F.R. §1.131 must be evaluated on a claim-by-claim basis. Specifically, 37 C.F.R. §1.131(a) states that “[w]hen any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim . . . may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.” (Emphasis added). Indeed, it is well-established that if an independent claim is patentable, then any claims depending therefrom are also patentable for at least the reasons supporting the patentability of the independent base claim. Accordingly, if an antedating Declaration is deemed effective to remove a reference as prior art to an independent claim, it is irrelevant as to whether the declaration is effective to remove the reference as prior art to any dependent claims depending therefrom. Thus, the assertion set forth in the Office Action that “Applicant failed to provide evidence (e.g., proof of conception) of several limitations claimed *in the dependent claims*” is misplaced, and withdrawal of this assertion and entry of the antedating Declaration is respectfully requested.

Additionally, contrary to the assertions set forth in the Advisory Action, the Applicant submits that the antedating Declaration does indeed provide evidence (e.g., proof of conception)

regarding the subject matter recited in dependent claims 19-22. Specifically, claim 19 recites “an axially facing portion of said spinal implant defines at least two tool engaging elements to facilitate rotation of said spinal implant within said intervertebral space about said longitudinal axis”. Additionally, claim 20 recites that “said tool engaging elements are apertures”, and claim 21 recites that “said tool engaging elements are positioned diametrically opposite one another relative to said longitudinal axis”. Further, claim 22 recites that “said elongate member defines a pair of arcuate slots positioned diametrically opposite one another relative to said longitudinal axis, said arcuate slots being sized and configured to receive said tool engaging elements during rotation of said spinal implant about said longitudinal axis”.

The “at least two tool engaging elements” and the “pair of arcuate slots” recited in claims 19-22, as well as the configuration and position of the tool engaging elements relative to one another and the arcuate slots, are illustrated in Figures 1 and 3 of the subject application, and are described in the specification as follows: “The elongate plate 26 further defines a pair of curved or arcuate slots 39, 41 extending from opposite edges 42, 43 of the plate 26 and progressing inwardly toward the center of the plate 26 adjacent the longitudinal axis 33. In the illustrated embodiment, the arcuate slots 39, 41 extend along a common radius; however, other slot configurations and arrangements are also contemplated as falling within the scope of the invention. As illustrated in FIG. 1, the front end portion 17F of the cage 17 defines a pair of tool-receiving passages 44, 46. The passages 44, 46 are radially offset from and located on diametrically opposite sides of the longitudinal axis 18 and are positioned generally along the radius of the arcuate slots 39, 41.” (Page 7, lines 3-21).

The Applicant notes that the same tool engaging element 44, 46 and arcuate slots 39, 41 illustrated and described in the subject application are correspondingly illustrated in Figures 1 and 3 of the Invention Disclosure accompanying the antedating Declaration. The Applicant notes that the manipulation tool was not positively recited in claims 19, 20 and 22, and therefore does not constitute part of the claimed invention. Nevertheless, the Applicant has removed reference to the manipulation tool from each of claims 19, 20 and 23. For at least these reasons, the Applicant submits that the antedating Declaration provides ample evidence (e.g., proof of

conception) of the subject matter recited in dependent claims 19-22, as well as any of the other pending dependent claims.

Submitted herewith is a Declaration of Prior Invention in the United States under 37 C.F.R. §1.131 to remove U.S. Patent No. 7,195,643 to Jackson as prior art. The '643 patent has a purported effective U.S. filing date of August 29, 2003. However, the Applicant reserves the right to challenge the purported effective U.S. filing date of the '643 patent. The antedating Declaration is signed and dated by the inventor, and indicates that on a date prior to August 29, 2003, the invention disclosed and claimed in the subject patent application was conceived of by the inventor in the United States, as evidenced in the Invention Disclosure accompanying the antedating Declaration, coupled with due diligence from a date prior to August 29, 2003 up to the filing of the subject patent application (i.e., up to constructive reduction to practice of the invention).

To evidence reasonable diligence, a correspondence dated August 12, 2003 and addressed to the law firm of Woodard, Emhardt, Moriarty, McNett & Henry accompanies the Declaration, wherein instructions were given to prepare a draft patent application based on subject matter set forth in the Invention Disclosure. A draft patent application was prepared and subsequently reviewed/revised by the inventor, followed by filing of the subject patent application with the U.S. Patent and Trademark Office on January 15, 2004. The correspondence dated August 12, 2003 provides evidence that the Invention was complete and ready for patenting on a date prior to August 29, 2003, and that reasonable diligence was apparent from a point just prior to August 29, 2003 (i.e., August 12, 2003) up to constructive reduction to practice of the invention in the United States (i.e., the filing of the subject application).

The Applicant submits that the attached Declaration is effective to remove the '643 patent as prior art to the subject application. Accordingly, the Applicant respectfully requests withdrawal of the claim rejections based on the '643 patent. However, the Applicant reserves the right to refute the claim rejections set forth in the Office Action should the Declaration for any reason be deemed ineffective to remove the '643 patent as prior art.

Claim Amendments

Independent claims 1, 2, 25 and 26 and dependent claims 72 and 86 have been cancelled without prejudice for possible submission and consideration in a continuing application.

Claims 63, 73, 82 and 87 have been rewritten in independent form. The Applicant notes that independent claims 17 and 32 and dependent claims 63-66, 73, 82, 83 and 87 were solely rejected as being anticipated by U.S. Patent No. 7,195,643 to Jackson. As indicated above, the '643 patent to Jackson has been removed as prior art with regard to the pending claims, including independent claims 17 and 32 and rewritten independent claims 63, 73, 82 and 87. Accordingly, the Applicant has fully addressed each of the rejections set forth in the Office Action with regard to independent claims 17, 32, 63, 73, 82 and 87, and no other grounds of rejection are outstanding with regard to these claims. The Applicant therefore respectfully requests allowance of independent claims 17, 32, 63, 73, 82 and 87.

Dependent claims 8-10, 19, 23, 24, 66, 67 and 69 have been amended to depend from rewritten independent claim 63, dependent claims 3-6 and 74-77 have been amended to depend from rewritten independent claim 73, dependent claims 28-30, 33, 34 and 83-85 have been amended to depend from rewritten independent claim 82, and dependent claims 27 and 88 have been amended to depend from rewritten independent claim 87. Accordingly, each of the pending dependent claims now depends either directly or indirectly from independent claims 17, 32, 63, 73, 82 or 87, and each are submitted to be patentable for at least the reasons supporting the patentability of their corresponding independent base claim.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the Applicant's application is now in condition for allowance with pending claims 3-24, 27-34, 63-71, 73-85 and 87-90.

Reconsideration of the subject application is respectfully requested. Timely action towards a Notice of Allowability is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

By: 

Brad A. Schepers
Reg. No. 45,431
Krieg DeVault LLP
One Indiana Square, Suite 2800
Indianapolis, Indiana 46204-2079
(317) 238-6334 (voice)
(317) 238-6371 (facsimile)